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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,442	Applicant(s) WHITTAKER ET AL.	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-9 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a final Office action. Claims 1-3, 7-9 and 17-24 are examined below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-3, 7, 9, 17 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Christy (U.S. Patent No. 4,074,474).

Claim 1: Christy discloses an apparatus for isolating and leveling a machine foundation with respect to a substructure comprising a rigid enclosure (Fig. 9) having a substantially hollow upper portion (see "A" from attached Fig. 9, below, the spacers show that it is substantially hollow) telescopically adjustably connected to a substantially hollow lower portion ("B" below) to provide for various sizes of the enclosure,, means for rigidly connecting the upper portion of the enclosure to the lower portion ("C" below) for fixing the position of the

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upper portion with the lower portion and means for providing leveling adjustment ("D" below; the inflatable portion) of the foundation.

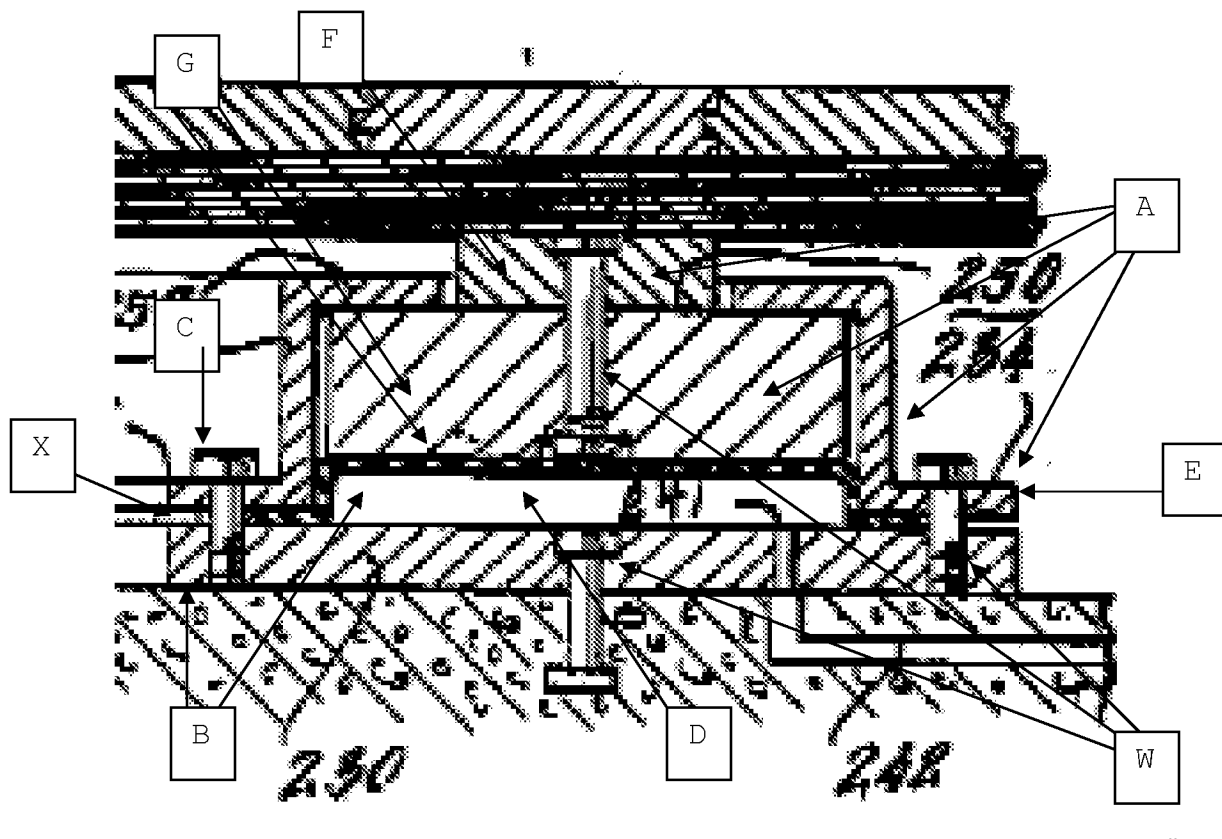


Figure 9 from Christy

Claim 2: the upper portion has a flange ("E" above) having an aperture extending therethrough (the bolt is in the aperture) and the lower portion has an anchor ring (230; see Fig. 9, generally where it is ring-shaped; see Fig. 5) with at least one

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rod (the bolt, "C" above) connected thereto and extending through the aperture in the flange above the upper portion, and a slip joint (the connection between the upper and lower sections is a slip joint) connected to the flange of the upper portion for releasably connecting the rod to the flange.

Claim 3: the lower portion has an anchor ring (230; see Fig. 9, generally where as shown this is a ring-shaped device, the upper surface extends into the interior as it is a part of the interior; see also Fig. 5) a bearing member ("F" above) within the enclosure and adjustable connecting to the anchor ring (via the leveling means) to provide a leveling adjustment of the foundation, and a support member ("G" above, including inflatable portion) in contact with the bearing member and engageable with the substructure. The two members "engage" via the lower portion.

Claim 7: the support member is capable of being removed and is between the bearing member and substructure (12) and the support member can be replaced with other support members.

Claim 9: Christy discloses an apparatus for isolation and leveling comprising a rigid enclosure connectable to the machine foundation having a substantially hollow upper portion ("A" above) and a substantially hollow lower portion ("B" above) telescopically connected to one another, the lower portion

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having an anchor ring (230) that extends into the interior of the enclosure (the upper surface of the ring extends into the enclosure,) a bearing member ("F" above) disposed within the enclosure above the anchor ring, a plurality of fasteners (see "W" above) that connect the bearing member to the anchor ring in a vertically spaced relationship (see Fig. 9) for vertical adjustment of the anchor with the bearing member (the members can be loosened or tightened as needed for adjustment,) and a support member ("G" above and leveling means) in contact with the bearing member and engageable with the substructure for isolating the machine foundation from the substructure.

Claim 17: the support member is capable of being removably disposed between the bearing member and substructure and is replaceable.

Claim 21: the upper portion is tubular (it is in the shape of a ring, which is tubular) and having open ends (there is an open end on each side of the bearing member), the lower portion is substantially tubular (it is in the shape of a ring) and having open ends (see "X" above; the joints between the upper and lower portion on each side is an open end.)

Claim 22: Applicant should respectfully note that the limitation "fabricated" is considered product-by-process; therefore, determination of patentability is based on the

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product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985). The pieces are integral in that they are attached to each other.

Claim 23: the language "connectable...machine foundation" lines 2-4 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The open end at a top surface of the foundation would be proximate the bearing member as shown in Fig. 9 and the second open end at a bottom surface of the foundation would be as proximate "X" above and also 241. The applicant should respectfully note that the "machine foundation" is not positively claimed, so it is not considered, but rather only the capability of the prior art of record to perform the function with a foundation as claimed.

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Claim 24: the anchor ring has an inner perimeter (proximate "X") and the fasteners ("C" above) are arrayed around the anchor ring adjacent the inner perimeter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christy.

Claims 8 and 18: the species of Fig. 9 discloses an inflatable portion (232), but not that it is an air bag, as claimed; however, the species of Fig. 6 discloses the use of an inflatable air bag (containing portion 172.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to substitute the inflatable portions because the species are obvious variants of each other and the inflatable element serves the same function in both species and would perform equally as well.

Claim 19: a conduit (242) coupled to and in communication with the inflatable portion (which would be the air bag) and while the particular species in Fig. 9 does not disclose a pressurized air source for communicating pressurized air to and from the bag, the species in Fig. 4 discloses the device (92). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because the inflating system would obviously require a device for inflation and deflation and the apparatus in Fig. 4 would clearly provide such a means for inflation.

Claim 20: a conduit (242) extending through the substructure (12) and into the enclosure where the conduit communicates with the inflatable portion (which would be the airbag.)

Response to Arguments

3. The following addresses applicant's remarks/arguments dated 21 October 2008:

Claim Rejection - 35 USC §102(b):

The examiner respectfully disagrees with applicant's argument that the upper and lower enclosure portions of Cristy (cited above) are not adjustably connected to one another. The examiner notes applicant's exhibit A and notes that this is what the examiner considered the upper and lower portions, respectively, however, a portion of "A" including portion 250 will telescopically adjust with respect to the inflation or deflation of portion "D" above. Further, depending on the level of inflation of portion "D" above, the enclosure can vary in size.

Regarding applicant's argument that applicant's characterization is "a hindsight reconstruction of the claimed invention" the examiner respectfully disagrees. The examiner interprets the claims as broadly as reasonably possible in light of the specification, but the limitations of the specification are not to be construed into the claims. Impermissible hindsight applies to obviousness rejections, and in the instant

case, the rejections were made as a matter of anticipation, and the examiner maintains that the prior art of record anticipates the limitations as claimed. Regarding applicant's discussion of "a rigid enclosure", the examiner maintains that the connection is rigid (Fig. 9: portion 240 is rigidly connected to member 230 via the attachment members).

Regarding claim 3, the examiner agrees with applicant's definition of a "ring". The examiner points applicant to Fig. 5 which shows the members in the shape of rings. These support elements are round in shape, and thus, a ring. Further, regarding applicant's indication of a support member contacting a bearing member and the intermediate support along with the upper portion of the housing, the examiner intended this to be part of the action. Applicant has respectfully not provided any structural limitations to define the members of the present invention, so the examiner used the broadest reasonable interpretation in light of the specification. In other words, the examiner made the rejection as though the intermediate support is a part of the upper portion (see for example claim 2, where the upper portion has a flange; with this rationale, the upper portion can also have an intermediate support.)

Regarding claim 9, the examiner maintains the rejection as proper because these members do connect the bearing member to

the anchor ring. While it may not be a direct connection, a connection exists indirectly via the members as claimed.

Regarding claims 21-24, the applicant's arguments are respectfully not persuasive because the examiner states, as in the rejection of claim 3, that the members are in the shape of a ring (see Fig. 5, generally), and in viewing the support from plan view (i.e., from the top), the members form a ring, which is tubular. Per the limitation addressing the "integral body" of claim 22, the examiner maintains that member 252 is an integral piece, and while separate from other portions of the upper member, it is integral in of itself. Per claim 23, the examiner maintains that that the claim language is purely functional, and as long as the prior art is capable of performing the limitation as claimed, then it meets the claim. Per claim 24, applicant has respectfully not provided any limitation to define the location of the inner perimeter, so the examiner identified it as "X" in the Office action (same as before), which is an inner perimeter of a ring (see Fig. 5). The fasteners are adjacent this periphery in that they are next to the periphery.

Claim Rejection - 35 USC §103:

The examiner respectfully disagrees with applicant's assumption that replacing member 232 with member 172 would result in a structure that is no longer hollow. The examiner respectfully disagrees in that the inflated portion would result in a substantially hollow member. Just as portion indicated as "D" aids in defining the hollow member, the air bag would equally define an open, or hollow space, when inflated.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635
/Basil Katcheves/
Primary Examiner, Art Unit 3635